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REMARKS

This is a Continued Examination application. By the present Amendment, claims 10, 41, 66 and 87-92 have been cancelled and no claims have been added. In addition, claims 1, 12, 14-16, 31, 43, 46, 47, 58, 68 and 70-72 have been amended. Accordingly, claims 1-8, 12-23, 27-40, 43-65, and 68-86 are now pending in the application. The amendments to the claims are supported by the specification and figures. Accordingly, no new matter is believed to have been introduced in the present application.

The Examiner's rejections are traversed below.

Rejection Under 35 U.S.C. Section 112

Claim 43 stands rejected under 35 U.S.C. Section 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim, the subject matter that applicant regards as the invention.

The Examiner states that the dependency for claim 43 appears incorrect. Applicant has corrected the dependency as noted by the Examiner. The Examiner's careful review of the present application is appreciated.

Accordingly, Applicant respectfully submits that claim 43 satisfies the requirements under 35 U.S.C. Section 112, second paragraph. Withdrawal of this rejection is respectfully requested.

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Rejection under 35 U.S.C. § 103(a) over Fields et al. (US Patent Number 5,111,391)

In the Office Action, claims 1-8, 17-23, 27-41, 43-66 and 68-92 are rejected under 35 U.S.C. § 103(a) over U.S. Pat. No. 5,111,391, Fields *et al.* ("*Fields*"). The rejection, insofar as it may be applied to the claims as amended, is respectfully traversed for the reasons indicated below. Reconsideration of the application and withdrawal of the rejection is respectfully requested.

For the reasons including, inter alia, those discussed below, each of independent claims 1, 31 and 58 is patentable over the applied reference. Applicant's prior arguments are hereby incorporated by reference. Further, claims dependent from these independent claims are deemed patentable.

Applicants respectfully traverse the rejection and respectfully submit that the presently claimed invention is not described by Fields et al. Applicants discuss the rejection below as it applies to independent claims 1, 31, and 58; dependent claims 2-8, 17-23, 27-30, 32-40, 43-57, 59-65, and 68-86 (Claims 10, 41, 66 and 87-92 having been cancelled without prejudice or disclaimer).

Without conceding that Fields discloses any of the features of the present invention,

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Fields clearly does not teach a computer-implemented method of dynamically scheduling an arbitrary number of resources from among a plurality of resources of a work-producing system. The Examiner argues that Fields et al. teach a system that can be used to for any type of resource allocation. The Examiner admits that the Fields et al. does not explicitly teach a system comprising a pharmacy and further asserts that it would be "obvious to one of ordinary skill to use the work producing system in a pharmacy...to schedule employees in any type of resource/task environment." Unlike the claimed invention, Fields et al. does not disclose a system that dynamically schedules resources and further, does not disclose a system that dynamically schedules resources in a pharmacy. Fields is only concerned with the "creation of staff schedules at remote locations." In contrast to the claimed invention, Fields et al. considers resources as merely "constraint variables" in the "job of creating staff schedules." Further, the combination of features recited in claim 1 are not shown or suggested by the prior art.

The Examiner argues that "rate per task" is taught or suggested by Fields' fixed ratio between units processed in a task and time period. Applicant does not admit that Fields teaches or suggests a rate per task. The Examiner equates units processed to tasks. Moreover, the current and prior Office Actions cite Fields' fixed ratio between units processed in a task and time period as meeting the recitation of rate per task and tasks performable per resource. **Clearly, Fields' fixed ratio cannot meet the limitations of two separately claimed elements.**

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In connection with claim 1, the Examiner states that "distributing pharmaceuticals" is understood to refer to the limitation "filling the pharmaceutical order." The claims recite, "dispensing a pharmaceutical prescription as part of the pharmaceutical order." Fields fails to teach or suggest at this recited element. The Examiner therefore is respectfully requested to withdraw the rejection.

As previously explained, staffing a pharmacy is more specialized than simply staffing Fields' "multi-unit retail locations" (col. 1 line 15). One example of several problems identified in the background of the invention concerns "scheduling to substantially optimally staff pharmacies on a day-to-day basis, and more particularly, to solving scheduling problems where resources perform a varying set of tasks and their individual rates (units/man hours) for each task vary." Accordingly, the applicants "have determined that the use of such techniques is new to the managed care, health care and/or pharmacy industry" (specification pages 1, 7-8). The specification discusses, *inter alia*, advantages, as the subject of the inventors' Declaration, and is evidence to be considered in reaching a conclusion as to obviousness. Further, Fields admits "each remote location has unique differences in layout, sales patterns, sales volume, and product mix" and "these differences are further complicated by uniqueness of each day of the week and seasonality of the year." (*See Fields et al.*, Col.1, lines 46-52) The present invention centers around a generic software application applied broadly to, for example, mail-order and point of sale pharmaceutical distribution, supply chain, and pharmacy benefit management. (specification, Page 24, lines 16-21) Hence, any contention that Fields would be useful in scheduling resources

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in a pharmacy is nothing more than an impermissible application of hindsight.

The Office Action apparently concedes to applicant's argument that Fields itself teaches away from complex scheduling problems. Fields teaches that creating an optimized staff schedule presents a problem of "linear complexity" (Col. 1, lines 55-57). The prior art must be considered in its entirety, including portions that would lead away from the claimed invention. This is a strong indication that subject matter that is not expressly mentioned in Fields may be included, if at all, only with great difficulty. This must be taken into account when determining patentability, particularly when the Examiner argues that subject matter is "inherent" or "well known" and would have been combined with Fields. Indeed, the Examiner routinely attempts to argue that subject matter is inherent or well known, to the contrary of Fields' teaching away.

The Examiner has essentially maintained the same rejections, while elaborating to some degree on the basis of her reasoning. For example, in several places of the Office Action the Examiner indicates that certain features are "implied," "implicit" or "inherent" in the prior art. See, e.g., pages 3, 4 and 15 of the Office Action. **The patent courts have held that this is an inappropriate consideration as part of an obviousness rejection.**

Specifically, the law is clear that an obviousness rejection does not incorporate inherent subject matter. For example, the Patent Office Board of Appeals has stated in a non-precedential opinion of *Ex parte Schriker*, 56 USPQ2d 1723, 1725 (B.P.A.I. 2000) (unpublished):

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[T]he examiner talks in terms of inherency (which is really an anticipation rationale) while on the other hand the examiner talks in terms that it would have been obvious to experiment to divine optimum conditions.

Inherency and obviousness are somewhat like oil and water - they do not mix well. Claimed subject matter can be anticipated because a prior art reference describes a method which inherently meets the limitations of a claimed method. Claimed subject matter can be unpatentable for obviousness when, notwithstanding a difference between that subject matter and a prior art reference, the claimed subject matter, as a whole, would have been obvious. However, when an examiner relies on inherency, it is incumbent on the examiner to point to the "page and line" of the prior art which justifies an inherency theory. Compare *In re Rijckaert*, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the prior art) (citing *In re Yates*, 663 F.2d 1054, 1057, 211 USPQ 1149, 1151 (C.C.P.A. 1981)).

In addition, both the Federal Circuit Court of Appeals, and its predecessor court, the Court of Customs and Patent Appeals, has similarly held that inherency and obviousness are not to be combined in the same rejection:

In re Spormann, 363 F.2d 444, 150 USPQ 449, 452 (C.C.P.A. 1966):

That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.

In re Newell, 891 F.2d 899, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989):

[A] retrospective view of inherency is not a substitute for some teaching or suggestion which supports the selection and use of the various elements in the particular claimed combination.

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In view of the above, Applicants respectfully submit that claim 1 is unobvious over the cited reference and respectfully request that the rejection under 35 U.S.C. § 103(a) of claim 1 be withdrawn.

Independent Claim 31 stands finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Fields. For the reasons discussed above, it is respectfully submitted that the combination of features recited in claim 31 as amended is patentable over Fields when interpreted as a whole. The Examiner is respectfully requested to withdraw the rejection of claim 31.

Independent Claim 58 stands finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Fields. For the reasons discussed above, it is respectfully submitted that the combination of features recited in claim 58 as amended is patentable over Fields when interpreted as a whole. The Examiner is respectfully requested to withdraw the rejection of claim 58.

With respect to the rejected dependent claims 2-8, 17-23, 27-30, 32-40, 43-57, 59-65, and 68-86 (Claims 10, 41, 66 and 87-92 having been cancelled without prejudice or disclaimer), Applicants respectfully submit that these claims are not only allowable by virtue of their dependency from independent claim 1, 31 and/or 58, but also because of additional features they

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recite. The omission of a claim from the following discussion is not to be construed as an admission that the Office Action is correct. Rather, the below discussion is exemplary of one or more of the additional features that are separately considered to be patentable, even though additional dependent claims are considered to include separately patentable subject matter.

Claim 2, for example, recites a method of "dynamically scheduling an arbitrary number of resources" comprising the step of "redetermining the at least one queue after assignment of the available resources," and "designating the assigned resource unavailable until a predetermined time when the assigned available resource expires." Unlike the claimed invention, Fields et al. does not disclose a system that dynamically schedules resources. Fields neither teaches nor suggests redetermining the at least one queue after the assignment of available "resources" as claimed, or designating the assigned "resource" as unavailable until a time when the "resource" expires, as further claimed. Fields is concerned with the dividing the "schedule into shifts" by the "process of first placing tasks at the highest skill level and then trying to move the task to a lower skill level. Further, Fields is concerned with employee's skill level and is not concerned with resources. In contrast to the claimed invention, Fields et al. considers resources as merely "constraint variables" in the "job of creating staff schedules." Accordingly, the combination of features recited in claim 2 is submitted to be patentable over the prior art of record.

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Claim 20 recites a method of "dynamically scheduling an arbitrary number of resources" according to claim 1, wherein "assigning step (b), further comprises the steps of assigning the available resources to the at least one task with a work flow between tasks following a Markov Chain." Unlike the claimed invention, Fields et al. does not disclose a system that dynamically schedules resources. The Examiner admits that Fields does not teach explicitly the use of Markov Chains but argues that one of ordinary skill in the art would be motivated to use Markov Chains as it would "allow the user to easily picture the flow between tasks." To the contrary, Fields does not teach or provide motivation to combine the method of dynamically scheduling resources with the use of Markov chain. Accordingly, the combination of features recited in claim 20 is submitted to be patentable over the prior art of record.

In connection with claims 27 and 28, the Examiner takes notice "that it is old and well-known in the art that tasks in a pharmacy commonly include vertical fills, baker fills, prepack fills," etc. Unlike the claimed invention, Fields et al. does not disclose a system that dynamically schedules resources and further, does not disclose a system that dynamically schedules resources in a pharmacy. Fields is only concerned with the "creation of staff schedules at remote locations." This appears to be an assertion of specific knowledge and therefore must be supported by a citation to some reference work recognized as standard in the pertinent art.¹ The

¹ In this instance, the Office Action relies on the Examiner's personal knowledge or alleged well known facts. Accordingly, the Examiner is respectfully requested to provide a citation to a reference or an affidavit from the Examiner, or to withdraw the rejection. 37 CFR § 1.104(d)(2). MPEP § 2144.03.

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Examiner admits that the applicant is correct that the Examiner would have to provide references to support her use of Official Notice, but argues that this is the case "only if the Applicant makes a seasonable challenge regarding the use of Official Notice." **The applicant believes that adequate traverse to the Examiner's assertion of Official Notice have been provided and the Examiner has failed to provide documentary evidence to maintain the rejection. See 37 CFR 1.104(c)(2), MPEP § 2144.03**

For the reasons discussed above, it is respectfully submitted that claims 32-41, 43-57, 59-66, and 68-83 are patentable over Fields. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejection and allow the claims.

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CONCLUSION

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

In addition, each of the combination of limitations recited in the claims includes additional limitations not shown or suggested by the prior art. Therefore, for these reasons as well, Applicants respectfully request withdrawal of the rejection.

Further, there is no motivation shown to combine the prior art cited by the Examiner, and even if these teachings of the prior art are combined, the combination of elements of claims, when each is interpreted as a whole, is not disclosed in the Examiner's proposed combination. As the combination of elements in each of the claims is not disclosed, Applicants respectfully request that the Examiner withdraw the rejections.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that

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it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, Applicants reserve the right to pursue the original subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicants' best attempt at providing one or more definitions of what the Applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicants are seeking for this application. Therefore, no estoppel should be presumed, and Applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents.

Further, Applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary

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to obtain allowance, and only maintains the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, Applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.

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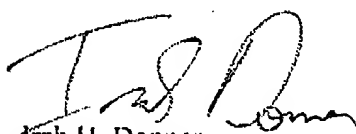
AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

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